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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,292	11/14/2001	Frederic Tisserand	680-010648-US(PAR)/ C2807	3864

2512 7590 07/23/2003

PERMAN & GREEN
425 POST ROAD
FAIRFIELD, CT 06824

EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 07/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,292

Applicant(s)

TISSERAND ET AL.

Examiner

Felix O. Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

This application includes terminology which is so different from that which is generally accepted in the art to which this invention pertains. In particular: indexation/indexing.

Applicant is required to provide a clarification of these matters or correlation with art-accepted terminology. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 3 and 9, it is unclear how the projections can be "provided in the stop arms" and be able "to engage the arms". It is unclear how the projections can be "provided in" and "engage" the same element. Although applicant's explanation may be clear, the claims do not coincide with the remarks presented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuwata et al. (US 5,813,878).

Kuwata discloses chip card connector comprising: a base frame (2) having integrated contact springs (6) and a closing cover (3) hinged from above the base frame; the closing cover including, in a side opposite the hinged side, two stop arms (15) having indexation tip members (16,17) that in a closed position are engaged under shoulders (9,10) provided on an edge (7) of the base frame, the stop arms being located away from lateral edges of the closing cover opposite each other.

Regarding claim 3, Kuwata teaches projections (at 16,17) provided in a front zone of the stop arms.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata in view of Matsuoka (4,715,835).

Kuwata discloses substantially the claimed invention except for the form of the arms. Matsuoka shows that a cover (5) having stop arms (8) formed from two small bars extending along three recesses (on each side of 8) open on one side of the cover,

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wherein the bars extending to a front zone in which they are widened, is an art recognized equivalent structure for covering a chip card. Therefore, because these two covers were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute of the cover of Matsuoka for the cover of Kuwata to cover the chip card.

Regarding claim 6, both Kuwata and Matsuoka disclose the indexing tip members being beveled to facilitate passage into the closed position.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata in view of Martucci (US 6,174,188).

Kuwata discloses substantially the claimed invention except for retaining member. Martucci teaches a card connector in which the base (2) has a retaining member (18,19) for fitting over a chip card is located on an edge that is close to an axis of rotation of the cover to help retain the card within the base frame. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the connector of Kuwata having a retaining member for fitting over a chip card is located on an edge that is close to an axis of rotation of the cover, as taught by Martucci, to help retain the card within the base frame.

Regarding claim 5, Kuwata teaches a hinged pins (not labeled) and Martucci teaches the cover being on a plane parallel to the retaining member.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwata in view of DeFrasne et al. (US 5,603,629).

Kuwata discloses substantially the claimed invention except for the spring member. DeFrasne teaches a card connector including a spring member (30) to aid opening the cover after the stop members are released. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the connector of Kuwata having a spring member, as taught by DeFrasne, to aid opening the cover after the stop members are released.

Response to Arguments

Applicant's arguments filed 06/0/03 have been fully considered but they are not persuasive.

In response to applicant's arguments that Kuwata does not show the stop arms being away from lateral edges of the cover, please note that the stop arms of Kuwata are located downwardly offset from the lateral edges, thus being away from the lateral edges.

In response to applicant's arguments that the stop arms of Kuwata are not adapted to be folded one against one another, please note that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Additionally, it is noted that the stop arms (16,17) on one side of the cover have to be folded against the stop arms on the other side of the cover.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Matsuoka discloses that the cover as shown fulfill a desirability of reduction of size and thickness of the overall structure (col.2 line 5-10); and it allow for more effective heat dissipation (col.1 lines 49-56).

In response to applicant's argument that it would not have been obvious to combine the references, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments that Matsuoka does not disclose "three slots", please note that the spaces on both side of the arms are considered to be slots / recesses. Additionally, it is also noted that the stop arms of Matsuoka are also located downwardly offset from the lateral edges, thus being away from the lateral edges.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

ffr
July 21, 2003


RENEE LUEBKE
PRIMARY EXAMINER